

REMARKS

After the amendments to the claims indicated above, claims 21-22, and 43-49 are pending in the present application. No claims have been added or cancelled by this Amendment. The remarks below support applicant's assertion that these claims are statutory and distinguish over the prior art, and are therefore in condition for allowance.

35 U.S.C. § 101

Initially, in the Office Action, claims 21, 22, and 43-49 were rejected under 35 USC 101 as not producing a "useful, concrete and tangible result." As to claim 21, and the claims depending therefrom, applicant respectfully traverses this rejection.

As of today, there is no precise, universal definition for a "useful, concrete and tangible result." This has left the PTO and applicants with a variety of prior court decisions and the burden of determining whether an applicant's claims are more like a court-approved result (i.e., statutory subject matter) or a court-rejected result (i.e., non-statutory subject matter).

Applying this process, applicant asserts that the claimed "deriving, using said recorded information, whether said first addressed content and said second addressed content were displayed on said computing device during overlapping time periods" (claim 21, lines 17-19) is analogous to the step of determining a billing amount for a telephone bill, the later being an approved result in AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). In each case, a mathematical algorithm is employed to make determinations related to timed events, and then cause some action to occur based on the determination (i.e., determine billing amounts and determine overlapping display times). Important to the court in AT&T, *supra*, was the fact that the claims did not pre-empt the use of

an algorithm. Similarly, claim 21 as amended does not pre-empt the use of an algorithm. Thus, claim 21 as amended is analogous to a court-approved (i.e., statutory) claim, and by this analogy provides a “useful, concrete and tangible result” and hence satisfies the requirements of 35 U.S.C. 101.

Furthermore, claim 21 includes the limitations “displaying first addressed content” and “displaying second addressed content”. These “displaying” steps are themselves statutory processes, and are not rendered non-statutory by combining them with of a “deriving” step in claim 21. Thus, applicant asserts that the rejection of claim 21 under 35 U.S.C. 101 is improper, as claim 21 is directed to statutory subject matter under that section of the statute.

Claims 22 and 43 through 48 each depend, directly or indirectly, on claim 21, and therefore contain all limitations of claim 21. Accordingly, as claim 21 provides a “useful, concrete and tangible result” so must claims 22 and 43 through 48, and hence satisfy the requirements of 35 U.S.C. 101.

Claim 49, has been amended herein to address the rejection under 35 U.S.C. 101. It is now directed to a storage medium having stored thereon a number of functional software objects. As such, the claim is directed to “functional descriptive material” (as defined by MPEP 2106) recorded on a computer-readable medium. As stated in MPEP 2106, “[w]hen functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.” Furthermore, since claim 49 as amended provides information to a server “for determining at least whether said information comprising said first software object and information comprising said second software object were displayed on a computing device during overlapping time periods” a

useful, concrete and tangible result. Thus, claim 49 as amended satisfies the requirements of 35 U.S.C. 101.

35 U.S.C. § 103

Claims 21-22 and 43-49 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Furst in view of Himmel et al. (Himmel) and Merriman et al. (Merriman). Applicant respectfully traverses this rejection as detailed below.

As previously explained, the present invention is directed to a method of keeping track of a user's interactions with certain types of software objects, and information related thereto. The software objects include addressed content which, while capable of being displayed by a web browser application, are actually rendered independent of a web browser application, to thereby allow a content provider to side-step the constraints on presentation of content imposed by traditional web browser user interfaces. Not so with the cited references. As explained, the teachings of each reference depend on, interact with, and are tied to a browser application.

Claim 21 recites that "the first frame and first addressed content [are] rendered independently from a Web browser program". (Claim 21, lines 4-5.) That is, no web browser program need be running or even accessed in order to render the frame and content according to the present invention. Likewise, claim 49 recites "the information includes instructions for invoking a first computing device resident process executable independent of a Web browser" (claim 49, lines 5-6 and 12-13). That is, the instructions are able to invoke a process without requiring interaction with a running Web browser application.

This is in stark contrast to the disclosure of Furst, which expressly states that the each tool is displayed as a web browser window. For example, Furst, col. 7, lines 62-65, states that

"[t]he client browser (that is, the web browser embedded in the client) generally maintains at least one client browser window for each active (that is, open) tool." Applicant finds no statements or suggestions in Furst which might be interpreted as a disclosure of rendering a "tool" independent of a web browser program. Indeed, there are many such references to Furst's dependence on a web browser, such as "[t]he discussion tool user interface is defined by a discussion tool home page, which is displayed in a client discussion tool window by the client's embedded browser...the discussion tool user interface is defined by a web page." (Furst, col. 9, lines, 12-16, emphasis added.) See also the windows (or frames) illustrated in Figs. 4A and 5 from Furst, in which one consistently finds the icon for Internet Explorer in the upper right corner, implying the dependence on an underlying browser program.

Likewise, Himmel and Merriman track a user's interaction with objects which must be programmed for, rendered with, and displayed completely within a typical web browser program. For example, Himmel describes a method of tracking the viewing of advertisements A-D 606-612 included in web page 194 (col. 8, lines 18-18). Likewise, Merriman tracks the click-through of objects such as banner advertisements "provided to the user's browser." (Merriman, col. 3, lines 53-56.) In both references the tracked objects are clearly not "rendered independently from a Web browser program" nor displayed "at least in part outside of a window of a Web browser program" as claimed in claim 21.

Accordingly, Furst, Himmel, and Merriman, alone and in combination depend upon a Web browser application for rendering. Indeed, according to the teaching of these references, taken alone and in combination, the objects to be rendered are themselves browser windows. This is in sharp contrast to the present claims.

As a matter of law, in establishing a *prima facie* case of obviousness relying on the combination of two [or more] references, the references must disclose a reason or motivation to combine their teachings to make the claimed invention. In re Dillon, 919 F. 2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(en banc), cert denied, 500 U.S. 904 (1991); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992). Furthermore, it is not enough to show that there is some abstract motivation for combining references. Rather, a person of ordinary skill in the art must be provided some motivation by the references to combine their teachings in the particular manner claimed. In re Koltzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). "In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998)(emphasis added). The burden is on the Examiner in the first instance to explain how the prior art suggests and motivates the proposed modification so as to render obvious the claimed invention. Ex parte Levy, 17 U.S.P.Q.2d 1461 (BPAI 1990).

The Patent Office has not met this burden with the conclusory statements that "it would have been obvious to one of ordinary skill in the art to combine the teachings of Himmel with Furst" (Office Action, page 4, lines 1-17), and "[i]t would have been obvious to one of ordinary skill in the art to combine the teaching of Merriman with Himmel and Furst" (Office Action, page 5, lines 8-9). Each such statement, in the words of the Board of Patent Appeals, "is a conclusion, rather than a reason." Ex parte Garrett, 1986 Pat. App. LEXIS 8, 4 (EPAI 1986).

In addition, by making the proposed combination, the Patent Office is suggesting modifying the teachings of the cited references such that the combination teaches rendering

independent of a Web browser, even though none of the cited references individually teach or suggest such a feature. Indeed, this modification is suggested in light of statements in the cited references that objects must be rendered as Web browser window. As a matter of law, such a drastic modification in the operating principles of the prior art precludes a finding of obviousness. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." M.P.E.P. § 2143.02.

Perhaps most critically, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). That is, even if the combination is permissible, it must still teach or suggest each claim element. Yet, even if the proposed combination of references were permissible (which applicant suggests is not the case), they fail to teach or suggest at least the feature of the claimed invention that objects are rendered independent of a Web browser program. Thus, no *prima facie* case of obviousness has been established.

In summary, (1) the cited references are improperly combined in the Office Action as there is no suggestion of why one skilled in the art would make such a combination; (2) the combination, even if permissible, would not teach the claimed feature of rendering an object independent of a Web browser window; and (3) the proposed combination would require further modification, such further modification being so significant that it represents an impermissible departure from the teachings of the cited references.

Accordingly, since claims 21 and 49 each directly contain the limitation that an object be rendered independent of a web browser, these claims cannot be *prima facie* obvious over the proposed combination of cited references. Likewise, claims 22 and 43 through 48 each depend, directly or indirectly, on claim 21, and therefore contain all limitations of claim 21. As the combination of the cited references fails to teach all elements of claim 21 and thus fail to render that claim *prima facie* obvious, for the same reasons the combination must also fail to teach all elements of claims 22 and 43 through 48, and thus fail to render those claims *prima facie* obvious over the combination of Furst, Himmel, and Merriman.

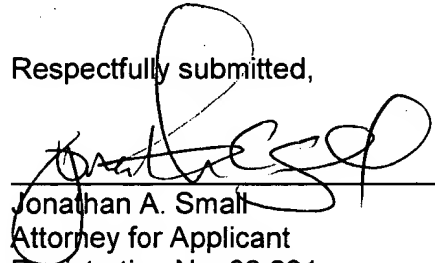
Conclusion

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration and issuance of a formal Notice of Allowance for this application in light of the amendments and remarks provided above is respectfully requested.

By action taken here, Applicant in no way intends to or causes any surrender of any subject matter or range of equivalents beyond that strictly required to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves without dedication all such subject matter and equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art.

If the Examiner believes that a telephone conference would expedite prosecution and allowance of this application, please telephone the undersigned at 650-941-4470.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jonathan A. Small', is written over a horizontal line.

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Date: June 6, 2006